UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/667,637	09/22/2000	G. Victor Guyan	07752.0019	8161

28164   7590   10/06/2006

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EXAMINER
FRENEL, VANEL

ART UNIT	PAPER NUMBER
3626	

DATE MAILED: 10/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

<table>
<tr><td rowspan="2">(
 Office Action Summary</td><td>Application No.
09/667,637</td><td>Applicant(s)
GUYAN ET AL.</td></tr>
<tr><td>Examiner
Vanel Frenel</td><td>Art Unit
3626</td></tr>
</table>

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>31 July 2006</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *2-11,13-22 and 24-33* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *2-11,13-22 and 24-33* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

Notice to Applicant

1.   This communication is in response to the Pre-Appeal Brief filed on 7/31/06.

Claims 2-11, 13-22 and 24-33 are pending.

2.   In view of the Pre-Appeal Request for Review filed on 7/31/06, PROSECUTION

IS HEREBY REOPENED as set forth below.

Claim Rejections - 35 USC § 103

3.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

4.   Claims 2-11, 13-22 and 24-33 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Peterson et al (6,343,271) in view of Murcko, Jr. (6,578,014).

(A)   As per claim 2, Peterson discloses the method wherein the step of capturing

comprises the steps of:

receiving claim identification information from a claimant, said claim identification

information comprising, at least, one line level (See Peterson, Col.3, lines 65-67 to

Col.4, line 20);

storing the line item level data in the insurance host server (See Peterson, Col.7,

lines 5-42);

providing a client with an item tree of line item level data based on the line level

and aggregating line item level data collected from the claimant (See Peterson, Col.11,

lines 34-52);

(C)   As per claim 3, Peterson discloses the method wherein the step of evaluating the

line item data comprises the steps of

displaying at least one line item from the insurance host server (See Peterson,

Col.13, lines 61-67 to Col.14, line 25);

receiving a selection of at least one line item from a claim handler (See Peterson,

Col.13, lines 1-13); and

receiving authorization from the claim handler to execute payment of the selected

line item, wherein said authorization is for a payment in a form comprising a direct

payment, vendor transfer, line item payment, or preauthorized payment (See Peterson,

Col.14, lines 46-67).

(D)   As per claim 4, Peterson discloses the method comprising steps performed by a

data processing system, of: capturing at least one line item data in an insurance host

server (See Peterson, Col.3, lines 65-67 to Col.4, line 20);

evaluating the line item data during the processing of an insurance claim (See

Peterson, Col.3, lines 65-67 to Col.4, line 20);

enabling the selection of a payment type (See Peterson, Col.10, lines 7-16);

wherein the step of fulfilling comprises the steps of: maintaining a vendor database on

the insurance host server (See Peterson, Col.7, lines 5-42);

placing at least one order for at least one line item from the insurance host server

to a vendor (See Peterson, Col.7, lines 5-42); and

tracking the order on the insurance host server (See Peterson, Col.4, lines 66-67

to Col.5, line 21; Col.7, lines 5-43).

Peterson does not explicitly disclose that the method having capture, evaluation

and fulfillment of line item level data, and fulfilling the payment of a line item based on

the evaluation of the line item data.

However, these features are known in the art, as evidenced by Murcko. In

particular, Murcko suggests that the method having capture, evaluation and fulfillment of

line item level data (See Murcko, Col.16, lines 32-65); and fulfilling the payment of a line

item based on the evaluation of the line item data (See Murcko, Col.16, lines 32-65).

It would have been obvious to one of ordinary skill in the art at the time of the

invention to have included the feature of Murcko within the system of Peterson with the

motivation of encouraging buyers to pay a fair amount for the items provided, and to

encourage sellers to provide items that are high value to the buyers to whom those

items are provided (See Murcko, Col.4, lines 43-49).

(E)   As per claim 5, Murcko discloses the method wherein the step of maintaining a

vendor database further comprises the step of entering vendor information in the vendor

database (See Murcko, Col.13, lines 21-42).

The motivation for combining the respective teachings of Peterson and Murcko

are as discussed in the rejection of claim 4 above, and incorporated herein.

(F)   As per claim 6, Murcko discloses the method wherein the step of maintaining a

vendor database further comprises the step of editing vendor information in the vendor

database (See Murcko, Col.13, lines 21-42).

The motivation for combining the respective teachings of Peterson and Murcko

are as discussed in the rejection of claim 4 above, and incorporated herein.

(G)   As per claim 7, Murcko discloses the method wherein the step of maintaining a

vendor database further comprises the step of upgrading a vendor to a preferred vendor

in the vendor database (See Murcko, Col.13, lines 21-42).

The motivation for combining the respective teachings of Peterson and Murcko

are as discussed in the rejection of claim 4 above, and incorporated herein.

(H)   As per claim 8, Murcko discloses the method wherein the step of placing at least

one order further comprises the step of faxing an order to a vendor (See Murcko,

Col.14, lines 47-67).

The motivation for combining the respective teachings of Peterson and Murcko are as discussed in the rejection of claim 4 above, and incorporated herein.

(I)   As per claim 9, Murcko discloses the method wherein the step of placing at least one order further comprises the step of emailing an order to a vendor (See Murcko, Col.14, lines 47-67).

The motivation for combining the respective teachings of Peterson and Murcko are as discussed in the rejection of claim 4 above, and incorporated herein.

(J)   As per claim 10, Murcko discloses the method wherein the step of placing at least one order further comprises the step of placing an order on a web server for vendor access (See Murcko, Col.13, lines 43-55).

The motivation for combining the respective teachings of Peterson and Murcko are as discussed in the rejection of claim 4 above, and incorporated herein.

(K)   As per claim 11, Murcko discloses the method wherein the step of placing at least one order further comprises the step of placing an order with a vendor by electronic data interchange (See Murcko, Col.13, lines 43-67).

The motivation for combining the respective teachings of Peterson and Murcko are as discussed in the rejection of claim 4 above, and incorporated herein.

(L)   As per claim 15, Peterson discloses a system for capturing line item data

comprising: a processor for executing programs (See Peterson, Col.8, lines 26-47); a

memory for storing a program executable by the processor, the stored program

including instructions for (i) capturing at least one line item data in an insurance host

server (See Peterson, Col.3, lines 65-67 to Col.4, line 20);

evaluating the line item data during the processing of an insurance claim (See

Peterson, Abstract, Col.1, lines 7-15);

wherein fulfilling includes (1) maintaining a vendor database on the insurance

host server (See Peterson, Col.7, lines 5-42);

(2) placing at least one order for at least one line item from the insurance host

server to a vendor (See Peterson, Col.7, lines 5-42); and (3) tracking the order on the

insurance host server (See Peterson, Col.4, lines 66-67 to Col.5, line 21; Col.7, lines 5-

43).

Peterson does not explicitly disclose fulfilling the payment of a line item based on

the evaluation of the line item data; and a user interface for enabling the selection of a

payment type associated with said at least one line item.

However, these features are known in the art, as evidenced by Murcko. In

particular, Murcko suggests fulfilling the payment of a line item based on the evaluation

of the line item data (See Murcko, Col.16, lines 32-65); and a user interface for enabling

the selection of a payment type associated with said at least one line item (See Murcko,

Col.16, lines 32-65).

It would have been obvious to one of ordinary skill in the art at the time of the

invention to have included the feature of Murcko within the system of Peterson with the

motivation of encouraging buyers to pay a fair amount for the items provided, and to

encourage sellers to provide items that are high value to the buyers to whom those

items are provided (See Murcko, Col.4, lines 43-49).

(M)   As per claim 26, Peterson discloses a computer readable medium containing

instructions for controlling a computer system to perform a method for capturing at least

one line item data in an insurance host server (See Peterson, Col.3, lines 65-67 to

Col.4, line 20);

evaluating the line item data during the processing of an insurance claim (See

Peterson, Col.3, lines 65-67 to Col.4, line 20);

enabling the selection of a payment type (See Peterson, Col.7, lines 5-42); and

wherein the step of fulfilling comprises the steps of:

maintaining a vendor database on the insurance host server (See Peterson,

Col.7, lines 5-42);

placing at least one order for at least one line item for the insurance host server

to a vendor (See Peterson, Col.7, lines 5-42); and

tracking the order on the insurance host server See Peterson, Col.4, lines 66-67

to Col.5, line 21; Col.7, lines 5-43).

Peterson does not explicitly disclose that the computer readable medium having

capturing, evaluating, and fulfilling line item data (See Murcko, Col.16, lines 32-65),

fulfilling the payment of a line item based on the evaluation of the line item data (See Murcko, Col.16, lines 32-65).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of Murcko within the system of Peterson with the motivation of encouraging buyers to pay a fair amount for the items provided, and to encourage sellers to provide items that are high value to the buyers to whom those items are provided (See Murcko, Col.4, lines 43-49).

(N)   Claims 13-14, 16-22, 24-25 and 27-33 recite the underlying process steps of the elements of claims 2-3 and 5-11, respectively. As the various elements of claims 2-3 and 5-11 and have been shown to be either disclosed by or obvious in view of the collective teachings of Peterson and Murcko, it is apparent that the apparatus disclosed by the applied prior art performs the recited underlying functions. As such, the limitations recited in claims 13-14, 16-22, 24-25 and 27-33 are rejected for the same reasons given above for claims 2-3 and 5-11, and incorporated herein.

Response to Arguments

5.   Applicant's arguments filed on 7/31/06 with respect to claims 2-11, 13-22 and 24-33 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

6.   The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited but not the applied art teaches system and method for

managing insurance claim processing (5,950,169) and system and method for

supporting delivery of healthcare (6,012,035).

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Vanel Frenel whose telephone number is 571-272-6769.

The examiner can normally be reached on 6:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Joseph Thomas can be reached on 571-272-6776. The fax phone number

for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

V. F
V.F

September 11, 2006

JOSEPH THOMAS
SUPERVISORY PATENT EXAMINER